

## **REMARKS / ARGUMENTS:**

Claims 105, 111, 115, and 121 have been canceled without prejudice and may be reasserted in this or another patent application.

Claims 103, 113, 120, 134 – 137 and 144 - 152 have been amended.

Claims 103, 113 and 120 have been amended by incorporating the description of the fungicide that was originally presented in claims 105, 111, 115 and 121, which have been canceled.

Claims 134 – 137 and 144 - 150 have been amended to correct dependency.

Claims 151 and 152 have been rewritten as independent claims by incorporating the provisions of claim 103, from which each of the claims depended. Accordingly, claims 151 and 152 now have the same scope as they did prior to the amendment.

No new matter has been added.

### **Allowability of claims 106, 112, 116 and 122 if rewritten in independent form including all of the limitations of the base claim and any intervening claims..**

The allowability of claims 106, 112, 116 and 122, if rewritten, is acknowledged with appreciation. The claims have now been amended so that all independent claims are patentable over the cited art, and all dependent claims should also be patentable.

### **Rejection of claims 103 – 105, 108 – 111, 113 – 115, 117, 118, 120, 121 and 134 - 158 under 35 USC §112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.**

It is respectfully requested that the rejection of claims 103 – 105, 108 – 111, 113 – 115, 117, 118, 120, 121 and 134 - 158 under 35 USC §112, first paragraph, as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention be reconsidered for the reasons discussed below and be withdrawn.

The Office now argues that although fungicidal agents are well known for their fungicidal effects, their use is not well known if they are ineffective for that purpose. It concludes, therefore, that the unpredictability of use for the claimed purpose is very high

and that a skilled practitioner would need more guidance than is provided in the specification to select fungicides that possess the claimed activity to enable the full scope of the broadest claims.

In other words, the Office has rejected claims that are admittedly novel and non-obvious on the grounds that the specification, in view of the state of the art, does not give a skilled practitioner a reasonable assurance that all embodiments within the scope of the claims will work.

It is well established that in order to support a rejection for lack of enablement when there is no lack of clarity or ambiguity in the claims, the Office is required to provide an explanation of why it doubts the truth or accuracy of any statement in a supporting disclosure backed up with acceptable evidence or reasoning which is inconsistent with the contested statement (*In re Marzocchi and Horton*, 169 USPQ 65, 367 (C.C.P.A. 1971). The only reasons the Office has provided essentially boil down to the broad scope of the fungicide: (“encompassing all known fungicidal agents”, “quite extensive both structurally and metabolically”, “unreasonable to extrapolate a broad activity such as plant growth enhancement to the entire class of fungicides” (no reasons given as to why this would be unreasonable), “no more reason to expect any fungicide selected in accordance with the invention to increase vigor and/or yield, than there is to expect it to do absolutely nothing”). As to the last statement, the Applicant respectfully maintains that its clear and unambiguous description in the specification of how to practice the invention, bolstered by an example, provides a reason to expect a claimed fungicide to increase vigor and/or yield. With respect, it is the Office that has presented no evidence or acceptable reason why a claimed fungicide would do absolutely nothing.

Accordingly, the Applicant maintains that the Office has failed to carry its burden of providing evidence or reasoning, other than conclusory statements, that provide an explanation of why the present claims fail to enable the full scope of the invention.

However, if the Office insists upon maintaining its position on this ground of rejection, the Applicant, in the spirit of furthering the prosecution of the present application, and without agreeing with or acquiescing to the reasoning presented by the Office, has amended the claims to obviate further contention of this ground of rejection.

In the present Action, the Office has allowed claims directed only to silthiofam. However, the Applicant maintains that such drastic restriction in scope for novel and non-obvious claims is not only unjustified, but is clearly against the letter and spirit of the law. Claims 103, 113, 120 and claims that depend therefrom, have been amended to limit the fungicide to a general structure that encompasses silthiofam. The structure presented is fully defined and each and every structure that is embodied is described with particularity. Because the Applicant has provided an example showing the efficacy of silthiofam in the method of the invention, it is maintained that one of ordinary skill would reasonably expect any fungicide sharing the general chemical structure that is described, and which meets all other criteria of the claims, to have the claimed activity.

In claims 151 and 152, the fungicide structures that are described present precise definitions for each and every member of the group that shares the general structure that is shown. Accordingly, there is no ambiguity as to which compounds are included in the claim and no undue experimentation is required to practice the claimed invention. As the Applicant has maintained previously, whether experimentation is undue does not pertain to how much, but to what degree of innovation is required. Here, none is required. Once an agronomic plant is selected, one must merely look up what fungal pests are pathogenic for the plant, and select a fungicide from those described in the claim which does not have activity against the fungal pests of the plant. All of this information is readily available from the literature.

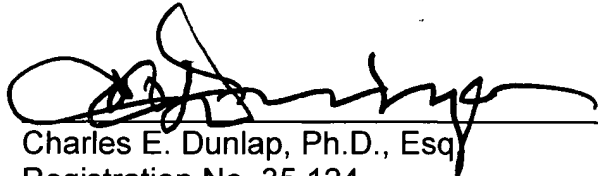
Accordingly, it is maintained that each of the present claims is fully supported and enabled in the specification in a manner that meets the requirements of 35 USC §112, first paragraph, and it is respectfully requested that the present rejection be reconsidered and withdrawn.

Request for reconsideration:

It is respectfully requested that the claims be reconsidered after consideration of the reasons for allowability that are discussed above and be found to be allowable. If one or more of the claims are found to not be allowable, a telephone call to the undersigned would be appreciated in order to resolve any remaining issues.

Respectfully submitted,  
**Nelson Mullins Riley & Scarborough LLP**

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Charles E. Dunlap, Ph.D., Esq.  
Registration No. 35,124

1320 Main Street, 17<sup>th</sup> Floor  
Columbia, SC 29201  
Telephone: (864) 250-2238  
Facsimile: (803) 255-9831  
Customer No. 45850